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10/092,379	03/06/2002	Jeffrey M. Dils	11136/10 (PTG-0867-US)	9764

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GENERAL NUMBER 00757
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EXAMINER

HOWELL, DANIEL W

ART UNIT	PAPER NUMBER
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3722

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DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,379

Applicant(s)

DILS ET AL.

Examiner

Daniel W. Howell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,28,30-32,34-41,43-46,48-61 and 65-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 67,68,70 and 77-79 is/are allowed.
- 6) ☒ Claim(s) 27,28,30-32,35,36-41,44-46,49-53,55-61,65,69 and 71-76 is/are rejected.
- 7) ☒ Claim(s) 34,43,48,54 and 66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The only measuring or detecting device which has been disclosed is a bubble level. Applicant's arguments provided on September 23, 2002, explicitly state that a bubble level may be considered as either a detecting or measuring device. Lines 14-19 of page 5 of the specification explicitly state that the electrical contacts provide **"a power source to a light bulb contained within the light housing."** No other use for the contacts 46 are disclosed. Claim 36 sets forth a measuring device (bubble level), and claim 37 states that "the measuring device is in electrical communication with the battery." This limitation of claim 37 is **new matter**. Lines 14-19 of page 5 only give disclosure that the contacts are for the light source. **There is no original disclosure that the contacts 46 have any interaction with the bubble level. Therefore, claim 37 constitutes new matter.**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 36, 39, 40, 45, 49, 50, 52, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf in view of Lee '458. Wolf shows a power drill having a housing 1, a handle 7, and a measuring device/bubble level 13 located on the housing. The bubble level has a

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body 15 and sensor 13, and the body 15 fits in slots 9 or 21 of the housing. Wolf is clearly a corded-type drill, which requires that the drill be used near an electrical outlet. Lee shows that it is well known to provide a power drill with a battery as shown at 24, the battery being perpendicular to the handle. In view of this teaching of Lee, it is considered to have been obvious to have provided Wolf with a battery located perpendicular to the handle in order to be able to use the drills in locations not having a nearby electrical outlet.

4. Claims 36, 38-41, 44-46, 49-53, 55, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over German '051 in view of Lee. Figure 1 of German '051 shows slots in the motor housing and handle for insertion of a bubble levels (measuring device), while figure 2 shows magnetic clamp rings for attaching bubble levels to either the motor housing or handle. The magnets and clamp rings of figure 2 and the corresponding surfaces on the drill housing and handle are considered to be fasteners. German '051 is clearly a corded-type drill, which requires that the drill be used near an electrical outlet. Lee shows that it is well known to provide a power drill with a battery as shown at 24, the battery being perpendicular to the handle. In view of this teaching of Lee, it is considered to have been obvious to have provided German '051 with a battery located perpendicular to the handle in order to be able to use the drills in locations not having a nearby electrical outlet.

5. Claims 36, 38, 40, 44, 50, 51, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funakubo in view of Lee. Funakubo shows a housing 1, handle 3, and detecting device (bubble level) 9 attached to the housing by a screw 11. Funakubo is clearly a corded-type drill, which requires that the drill be used near an electrical outlet. Lee shows that it is well known to provide a power drill with a battery as shown at 24, the battery being

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perpendicular to the handle. In view of this teaching of Lee, it is considered to have been obvious to have provided Funakubo with a battery located perpendicular to the handle in order to be able to use the drills in locations not having a nearby electrical outlet.

6. As stated at MPEP 608.01(m), each claim must end with a period, and periods may not be used elsewhere in the claims except abbreviations. Many of the claims of record set forth multiple items such as a, b, and c, with a period after each of these letters. These periods should be replaced with appropriate parentheses.

7. Claims 27, 28, 30, 35-36, 38, 40, 44, 45, 49, 50, 51, 55, 72, 74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palm in view of Funakubo. Palm shows a power tool having a motor housing 12, handle 14, and battery which has a component extending in a direction perpendicular to the handle and parallel to the tool axis. On the power supply end of the handle is a light 30 which directs light upwardly and forward on the drill bit (column 2, lines 10-16). See lens 36. Palm lacks a detecting or measuring device to determine the angle of the drill bit with the workpiece. Funakubo shows a bubble level (measuring/detecting device) mounted on the upper surface of the drill housing, the bubble level showing the angle that a drill bit forms with a workpiece. The bubble level is secured to the drill housing by a screw 11 which mates in a threaded hole in the drill housing. It is considered to have been obvious to have provided Palm with a bubble level as taught by Funakubo in order to drill a hole at a desired angle in a workpiece.

8. Claims 27, 28, 30-32, 35, 36, 38-41, 44-46, 49-53, 55, 71, 72, 74, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palm in view of German '051. Palm shows a power tool having a motor housing 12, handle 14, and battery which has a component extending

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in a direction perpendicular to the handle and parallel to the tool axis. On the power supply end of the handle is a light 30 which directs light upwardly and forward on the drill bit (column 2, lines 10-16). See lens 36. Palm lacks a detecting or measuring device to determine the angle of the drill bit with the workpiece. Figure 1 of German '051 shows slots in the motor housing and handle for insertion of a bubble levels (measuring device), while figure 2 shows magnetic clamp rings for attaching bubble levels to either the motor housing or handle. The magnets and clamp rings of figure 2 and the corresponding surfaces on the drill housing and handle are considered to be fasteners. It is considered to have been obvious to have provided Palm with the bubble levels as taught by figures 1 and 2 of German '051 in order to be able to drill a hole at a desired angle in a workpiece.

9. Claims 27, 28, 30, 31, 32, 35, 36, 38-41, 44-46, 49-53, 55, and 71-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese '565 in view of German '051. The Japanese '565 device shows a hand drill having a motor housing 1, a handle 2, a battery 4, and a pivoting light 9. Note lens 8 in figure 2. As seen in figure 1, the light will point to the front of the tool being used. Japanese '565 lacks a detecting or measuring device to determine the angle of the drill bit with the workpiece. Figure 1 of German '051 shows slots in the motor housing and handle for insertion of a bubble levels (measuring device), while figure 2 shows magnetic clamp rings for attaching bubble levels to either the motor housing or handle. The magnets and clamp rings of figure 2 and the corresponding surfaces on the drill housing and handle are considered to be fasteners. It is considered to have been obvious to have provided Japanese '565 with the bubble levels as taught by figures 1 and 2 of German '051 in order to be able to drill a hole at a desired angle in a workpiece.

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10. Claims 56-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palm in view of German '051 as applied to claims 27 and 45 above, and further in view of Japanese '709. Palm does not show a cavity for storing items. Japanese '709 shows a cavity in the drill housing having a magnet 2 for storing bits 3. Note from figure 1 that this recess is generally perpendicular to the axis of the drill handle. It is considered to have been obvious to have provided Palm with a recess and magnet as shown by Japanese '709 for retaining bits to prevent losing them.

11. Claims 56-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese '565 in view of German '051 as applied to claims 27 and 45 above, and further in view of Japanese '709. Japanese '565 does not show a cavity for storing items. Japanese '709 shows a cavity in the drill housing having a magnet 2 for storing bits 3. Note from figure 1 that this recess is generally perpendicular to the axis of the drill handle. It is considered to have been obvious to have provided Japanese '565 with a recess and magnet as shown by Japanese '709 for retaining bits to prevent losing them.

12. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over French '164 in view of German '051. French '164 shows a drill housing having a power receiving handle 1 which may be equipped with a cavity in order to hold a chuck key 40. French '164 lacks a detecting or measuring device to determine the angle of the drill bit with the workpiece. Figure 1 of German '051 shows slots in the motor housing and handle for insertion of a bubble levels (measuring device), while figure 2 shows magnetic clamp rings for attaching bubble levels to either the motor housing or handle. It is considered to have been obvious to have provided

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French '164 with the bubble levels as taught by figures 1 and 2 of German '051 in order to be able to drill a hole at a desired angle in a workpiece.

13. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over French '164 in view of German '051 as applied to claim 65 above, and further in view of Lee. French '164 is clearly a corded-type drill, which requires that the drill be used near an electrical outlet. Lee shows that it is well known to provide a power drill with a battery as shown at 24, the battery being perpendicular to the handle. In view of this teaching of Lee, it is considered to have been obvious to have provided French '164 with a battery located perpendicular to the handle in order to be able to use the drills in locations not having a nearby electrical outlet.

14. Claims 67, 68, 70, and 77-79 are allowed.

15. Claims 34, 43, 48, 54, and 66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 703-308-1728. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 703-308-2159.

Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Center for Tech Center 3700 at 703-306-5648.

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In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1148.



Daniel W. Howell
Primary Examiner
Art Unit 3722